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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/522,274	03/09/2000	Regis Nicolas	PALM-3024.IPG.US.P	2735

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EXAMINER	
SAID, MANSOUR M	
ART UNIT	**PAPER NUMBER**
2673	16

DATE MAILED: 03/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/522,274	NICOLAS ET AL.	
	Examiner	Art Unit	
	MANSOUR M SAID	2673	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 January 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-11 and 13-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 3-11 and 13-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Reconsideration

1. This office action is in respond to the reconsideration respond filed on January 13, 2004. and amendment filed on July 16, 2003.

Claim Rejections - 35 USC § 103

2. **The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. **Claims 1, 4-5, 7, 10, and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Izutani (5,483,262) in view of Uchida (5,067,573).**

As to claims 1, Izutani teaches a computer system (figure 1, (10)) comprising a processor (figure 1, (11)) coupled to bus; a memory unit (figure 1, (13-14)) coupled to the bus; a display screen (figure 1, (15)) coupled to the bus, digitizer (the input type information processor, (figures 1-2, (10)); a case (unit, (figure 1, (17) for supporting the processor (column 1, lines 5-10), the memory unit ((figure 1, (13 & 14)), and the display screen (display unit, (figure 2a, (6)) and the digitizer (the input type information processor, (figures 1-2, (10)), the case (figure 2a, (17)) having a slot (pen holder, (figure 2a, (2)) located therein for receiving a stylus (pen, (figure 2a, (1)); a power (power switch, (figure 2, (3)) ,slot (holder, (figure 2, (2)) (column 3, lines 38-46) ,

a switch (power switch, (figure 2, (3)) coupled to power up the processor the display screen (figure 9) (column 1, lines 11-22), a power conservation mode when the stylus is inserted into the slot (column 1, lines 62-67 & column 2, lines 1-6).

Izutani does not teach an opening at one end of the slot and a non-mechanical detector for detecting the stylus.

However, Uchida teaches an opening at one end of the slot (pen receptacle, (figures 1-2, (23)) and column 59-67) and a non-mechanical detector for detecting the stylus (column 5, lines 15-30).

Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to combine Uchida's teaching detecting the stylus into Izutani's pen input device so to effect a mode change (column 2, lines 10-11).

As to claim 4, Uchida teaches the detector is located within the slot (pen receptacle, (figures 1-2, (23)) and is an electrical detector (detector associated with receptacle, (23), (column 1, lines 49-56).

As to claim 5, Uchida teaches the computer system is a palmtop computer system (hand-writing input apparatus, (figures 1-3)) (abstract and column 2, lines 31-67).

As to claims 7 and 17, Izutani teaches an on/off button (power switch, (figure 2, (3)) for placing the processor (CPU, (figure 1, (11)) (column 4, lines 30-35), the display screen (display unit, (figure 2, (6)) and the digitizer (digitizer (the input type information processor, (figures 1-2, (10)) into the power conservation mode when pressed wile the computer system is powered on and wherein the on/off button is for powering on the processor (column 1, lines 62-67 & column 2, lines 1-6), the display screen (display unit, (figure 2, (6))and the digitizer (digitizer (the input

type information processor, (figures 1-2, (10)) when pressed while the computer system is in the power conservation mode (column 1, lines 62-67 & column 2, lines 1-6).

As to claim 10, Izutani teaches a computer system (figure 1, (10)) comprising a processor (figure 1, (11)) coupled to bus; a memory unit (figure 1, (13-14)) coupled to the bus; a display screen (figure 1, (15)) coupled to the bus; a case (unit, (figure 1, (17) for supporting the processor (column 1, lines 5-10), the memory unit ((figure 1, (13 & 14)), and the display screen (display unit, (figure 2a, (6)) and the digitizer, (the input type information processor, (figures 1-2, (10)), the case (figure 2a, (17)) having a slot (pen holder, (figure 2a, (2)) located therein for receiving a stylus (pen, (figure 2a, (1)); a power (power switch, (figure 2, (3)) ,slot (holder, (figure 2, (2)) (column 3, lines 38-46) , a switch (power switch, (figure 2, (3)) coupled to power up the processor the display screen (figure 9) (column 1, lines 11-22), a power conservation mode when the stylus is inserted into the slot (column 1, lines 62-67 & column 2, lines 1-6).

Izutani does not teach an opening at one end of the slot and a non-mechanical detector for detecting the stylus.

However, Uchida teaches an opening at one end of the slot (pen receptacle, (figures 1-2, (23)) and column 59-67) and a non-mechanical detector for detecting the stylus (column 5, lines 15-30).

Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to combine Uchida's teaching detecting the stylus into Izutani's pen input device so to effect a mode change (column 2, lines 10-11).

As to claim 16, Izutani teaches that constantly supplying power (power supply unit, (figure 1, (19)) to the memory unit (figure 1, (13-14)) (column 2, lines 55-67).

4. Claims 3, 6, 11, and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Izutani in view of Uchida as applied to claims 1 and 10 above, and further in view of Ogawa (6,100,538).

As to claims 3, 6, 11 and 13, Izutani and Uchida teach all claimed limitation except that optical detector and a battery, which is supplying power to the computer.

However, Ogawa (figures 1-2) teaches an optical digitizer and display panel (6), a stylus (2) for an inputting device or pointer. Stylus that projects light directly or indirectly on a coordinate plane (1), the digitizer is provided with detector means units (3L and 3R) arranged around the coordinate plane (1) (column 6, lines 40-67), and also optical detector and a battery which is supplying power to the computer (abstract; column 2, lines 40-67; column 3, lines 40-56; column 4, lines 1-10; column 5, lines 19-30; column 9, lines 22-50; column 12, lines 30-62; and column 13, lines 1-25).

Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to combine Ogawa's optical digitizer device having optical detector and battery into Izutani's modified device so as to provide an optical digitizer capable of operating with stability with out being affected by extraneous light including light radiated from the display panel of the digitizer (column 2, lines 40-46).

As to claim 14, Uchida teaches the detector is located within the slot (pen receptacle, (figures 1-2, (23)) and is an electrical detector (detector associated with receptacle, (23), (column 1, lines 49-56).

As to claim 15, Uchida teaches the computer system is a palmtop computer system (hand-writing input apparatus, (figures 1-3)) (abstract and column 2, lines 31-67).

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Izutani in view of Uchida as applied to claims 1 above, and further in view of Dao et al. (5,049,862; hereinafter referred to Dao).

As to claim 8, Izutani and Uchida disclose all claimed limitations except that a first region for capturing stroke data associated with alphabetic characters and a second region for capturing stroke data associated with numeric characters.

However, Dao teaches (figure 1) a notebook (10) includes a first panel, a second panel (14) connected to first panel (12) by a hinge means (16) that allows both first and second panel to orient in a multitude of angles about hinge means, and a stylus (18) for writing on first panel and second panel. First panel (12) has flat surface (20) with an opaque first digitizer tablet (22) and allows placement of standard templates (column 3, line 60 through column 4, line 14); and a first region for capturing stroke data associated with alphabetic characters and a second region for capturing stroke data associated with numeric characters (figure 8, column 7, line 42 through column 8, line 3).

Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to combine Dao's portable computer having alphabetic and numeric character into Izutani's modified device to allow real-time coupling of manual paper form completion into machine recognizable form (column 1, lines 1-10).

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Izutani in view of Uchida as applied to claim above, and further in view of Snell (5,756,941).

Izutani and Uchida disclose all claimed limitation but omit that the digitizer is separate in area from the display.

However, Snell teaches that the digitizer is separate in area from the display (column 3, lines 50-67).

Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to have Snell's teaching into Izutani's modified system so as to increase the versatility of the device.

7. Claims 18-21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Izutani (5,483,262) in view of Uchida (5,067,573).

As to claims 18, Izutani teaches a computer system (figure 1, (10)) comprising a processor (figure 1, (11)) coupled to bus; a memory unit (figure 1, (13-14)) coupled to the bus; a display screen (figure 1, (15)) coupled to the bus, digitizer (the input type information processor, (figures 1-2, (10)); a case (unit, (figure 1, (17) for supporting the processor (column 1, lines 5-10), the memory unit ((figure 1, (13 & 14)), and the display screen (display unit, (figure 2a, (6)) and the digitizer (the input type information processor, (figures 1-2, (10)), the case (figure 2a, (17)) having a slot (pen holder, (figure 2a, (2)) located therein for receiving a stylus (pen, (figure 2a, (1)); a power (power switch, (figure 2, (3)) ,slot (holder, (figure 2, (2)) (column 3, lines 38-46) , a switch (power switch, (figure 2, (3)) coupled to power up the processor the display screen (figure 9) (column 1, lines 11-22), a power conservation mode when the stylus is inserted into the slot (column 1, lines 62-67 & column 2, lines 1-6).

Izutani does not teach an opening at one end of the slot; a non-mechanical detector for detecting the stylus and a hinge.

However, Uchida teaches an opening at one end of the slot (pen receptacle, (figures 1-2, (23)) and column 59-67); a non-mechanical detector for detecting the stylus (column 5, lines 15-30) and a hinge (hinge member, (figures 1-2, (9)) and column 2, lines 2, lines 45-52).

Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to combine Uchida's teaching detecting the stylus into Izutani's pen input device so to effect a mode change (column 2, lines 10-11).

As to claim 19, Uchida teaches wherein the detector is located within the slot (column 5, lines 15-30).

As to claim 20, Uchida teaches wherein the detector is located within the slot and is an electrical detector (detector associated with receptacle, (23), (column 1, lines 49-56).

As to claim 21, Uchida (figures 2a-2c) teaches wherein the computer system is a palmtop computer system (figures 1-3)) (abstract and column 2, lines 31-67).

As to claim 23, Izutani teaches an on/off button (power switch, (figure 2, (3)) for placing the processor (CPU, (figure 1, (11)) (column 4, lines 30-35), the display screen (display unit, (figure 2, (6)) and the digitizer (digitizer (the input type information processor, (figures 1-2, (10)) into the power conservation mode when pressed wile the computer system is powered on and wherein the on/off button is for powering on the processor (column 1, lines 62-67 & column 2, lines 1-6), the display screen (display unit, (figure 2, (6))and the digitizer (digitizer (the input type information processor, (figures 1-2, (10)) when pressed while the computer system is in the power conservation mode (column 1, lines 62-67 & column 2, lines 1-6).

8. Claims 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Izutani in view of Uchida as applied to claim 18 above, and further in view of Ogawa (6,100,538).

Izutani and Uchida teach all claimed limitations in claim 22 except that optical detector and a battery, which is supplying power to the computer.

However, Ogawa (figures 1-2) teaches an optical digitizer and display panel (6), a stylus (2) for an inputting device or pointer. Stylus that projects light directly or indirectly on a coordinate plane (1), the digitizer is provided with detector means units (3L and 3R) arranged around the coordinate plane (1) (column 6, lines 40-67), and also optical detector and a battery which is supplying power to the computer (abstract; column 2, lines 40-67; column 3, lines 4056; column 4, lines 1-10; column 5, lines 19-30; column 9, lines 22-50; column 12, lines 30-62; and column 13, lines 1-25).

Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to combine Ogawa's optical digitizer device having optical detector and battery into Izutani 's modified device so as to provide an optical digitizer capable of operating with stability with out being affected by extraneous light including light radiated from the display panel of the digitizer (column 2, lines 40-46).

9. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Izutani in view of Uchida as applied to claim 18 above, and further in view of Dao et al. (5,049,862; hereinafter referred to Dao).

Izutani and Uchida disclose all claimed limitations in claim 8 except that a first region for capturing stroke data associated with alphabetic characters and a second region for capturing stroke data associated with numeric characters.

However, Dao teaches (figure 1) a notebook (10) includes a first panel, a second panel (14) connected to first panel (12) by a hinge means (16) that allows both first and second panel to orient in a multitude of angles about hinge means, and a stylus (18) for writing on first panel and second panel. First panel (12) has flat surface (20) with an opaque first digitizer tablet (22) and allows placement of standard templates (column 3, line 60 through column 4, line 14).

Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to have Dao's teaching into Izutani' modified system so as to increase the versatility of the display device.

Response to Arguments

10. Applicant's arguments with respect to claims 1, 3 and 13-24 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to **Mansour M. Said** whose telephone number is **(703) 306-5411**.

The examiner can normally be reached on Monday through Thursday from 8:30 a.m. to 6:00 p.m. The examiner can also be reached on alternate Friday from 8:30 a.m. to 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Shalwala Bipin**, can be reached at **(703) 305-4938**

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist)

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer service Office Whose telephone number is (703) 306-0377.

Patent Examiner

March 11, 2004

Mansour M. Said

BIPIN SHALWALA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600